

Reply Under 37 CFR § 1.111
To Office Action of November 12, 2004

Docket No. 0445-0318P
Serial No. 10/049,828

REMARKS

Upon entry of the instant amendment claims 1 and 3-7 will remain pending in the instant application and stand ready for further action on the merits.

The amendments made herein to claims 1, 6 and 7 do not incorporate new matter into the application as originally filed.

For example, the amendment to claim 1 finds support in original claim 2 (now cancelled), Figures 1-4, and the specification at page 3, lines 16-30 and page 4, lines 4-18. Support for the amendment to claim 6 occurs at page 4, lines 1-3 and page 5, lines 22-25 of the specification. Support for the amendment to claim 7 occurs at page 3, lines 11-12.

Based on the above considerations, entry of the instant amendment is respectfully requested as is an early and favorable action on the merits.

Claim Rejections - 35 USC § 102(b)

Claims 1, 3 and 6-7 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by **Foreman US '677** (US 4,738,677). Claims 1-7 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by **Kitaoka US '637** (US 5,662,637). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Requirements for Anticipation

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Present Invention and its Advantages

The present invention relates to an absorbent article such as a disposable diaper, which has the characteristics of being:
(1) excellent in anti-leak properties, (2) good in workability

(or processibility), (3) exhibiting a satisfactory anti-leak effect even when a bulky topsheet is employed, (4) good in productivity and (5) low in manufacturing cost.

In particular, the present invention provides an absorbent article including a liquid-permeable topsheet, a liquid-impermeable backsheet and a liquid retentive absorbent core interposed between the topsheet and the backsheet, the absorbent article being substantially vertically elongated and having an upstanding gather, wherein the topsheet has a liquid shut-off region in a linear shape which prevents liquid migration within the topsheet, and the liquid shut-off region is located at an area outside the periphery of the absorbent core and is formed independent of a joined section between the topsheet and a sheet material for forming the upstanding gather.

Distinctions Over the Cited Art

Forman - US 4,738,677

In this document, the region (92), which the examiner called a liquid shut-off region in the outstanding office action, is located within the area absorbent core (44) as shown in Fig 1. This can be easily ascertained by viewing how the side edge (46) of the absorbent core (44) crosses the edge attachment means (92) in Figure 1 of Forman US '677. The language of the pending claims does not encompass such a construction.

Instead, in the presently claimed invention, the liquid shut-off region is located outside of the area of the absorbent core. In this respect, the edge attachment means (92) of Forman US '677 corresponds to jointed section S (e.g., see Figure 4) in disclosed in the instant specification and drawings. Therefore the prior art clearly differs from the instant invention as recited in pending claims 1 and 3-7, and is thus incapable of anticipating any of the pending claims.

In addition, Forman US '677 shows that not only a topsheet and a backsheet are adhered by adhesive agent at the point (92), but also a barrier cuffs and topsheet. For example, as shown in Figures 2 and 3, three sheets are adhered at the point (92). This structure is quite different from the invention recited in instant claim 1.

Kitaoka - US 5,662,637

As shown in Figures 1 and 2, the invention of Kitaoka US '637 needs the exposed zone (11) on the under crotch position of the coversheet (15). The exposed zone (11) causes what is known as "the wet back phenomena." This means that when a baby sits with its own weight, e.g., on the floor, liquid stored in the absorbent of diaper exudes. Such a problem is not associated with the inventive diapers claimed because the instantly claimed absorbent articles possess a structure wherein a "topsheet has a liquid

shut-off region in a linear shape over the longitudinal direction, which prevents liquid migration within said topsheet, and said liquid shut-off region is located at an area outside the periphery of said absorbent core and is formed independent of a joined section between said topsheet and a sheet material for forming said upstanding gather...." (See claim 1.)

Thus, because Kitaoka US '637 completely fails to disclose or teach such a structure, it follows that the same cannot anticipate any of the instantly pending claims.

Based on the above considerations, it is clear that the present invention is not anticipated by the cited art of Forman US '677 or Kitaoka US '637, as neither reference meets the full requirements and limitations of any of pending claims 1 and 3-7. As such withdraw of each of each of the outstanding anticipation rejections is required at present.

Additional Considerations

For completeness sake, it is also note that the cited art of record is incapable of rendering the present invention obvious under the provisions of 35 USC § 103(a), whether such references are considered singularly or in combination. This assertion is based on the fact that neither reference provides any teaching, suggestion or motivation to those of ordinary skill in the art that would allow them to arrive at the invention as claimed.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Conclusion

Based on the amendments and remarks presented herein it is submitted that the cited art is incapable of anticipating or rendering obvious any of instantly pending claims 1 and 3-7. As such the Examiner is respectfully requested to issue a notice of allowance indicating that each of the pending claims allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any questions concerning the present amendment, or any issues remaining after consideration of the instant amendment, the Examiner is respectfully requested to

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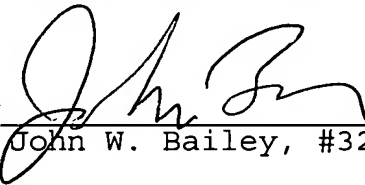
contact John W. Bailey (Reg. No. 32,881) at the telephone number indicated below, in order to help further prosecution of the present case.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 CFR §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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0445-0318P

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